

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PERI HARTMAN,
JEFFREY P. BEZOS,
SHEL KAPHAN,
and JOEL SPIEGEL

Appeal No. 2007-1992
Application No. 09/318,447
Technology Center 3600

Decided¹: September 26, 2007

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 108-123, 126-137, 151-156, 159-163, and 176-183. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ An oral hearing was conducted on Sep. 13, 2007.

The claimed invention is directed to a method and system for placing an order over the Internet. Claims 108, 126, 151, and 176 are the independent claims. Claim 108 is drawn to a method of ordering an item “*whereby [a] user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information.*” Claim 151 is drawn to a system comprising a “[a] client identifier identifying account information previously supplied by a user *wherein the user does not need to log in to the server system when ordering the item*; and a component that updates account information by coordinating the log in of the user to the server system, receiving updated account information from the user, and sending the updated account information to the server system.” Claim 176 is drawn to a method of ordering an item comprising the step of “generating an order for [an] identified item using [] account information associated with [a] received client identifier *wherein the user does not need to log in to the computer system to order the item*; and when account information is to be changed, coordinating the log in of the user to the computer system; receiving from the client system updated account information; and updating the account information associated with the client identifier of the logged in user based on the received updated account information.” Accordingly all three of claims 108, 151, and 176 provide that the user does not need to log in to the computer to order an item. Claim 126 is a method of ordering an item “*wherein the server computer automatically combines orders into a single order.*”

108. A method in a client system for ordering an item, the method comprising:

receiving from a server system a client identifier of the client system;
persistently storing the client identifier at the client system;
when an item is to be ordered,

displaying information identifying the item and displaying an
indication of a single action that is to be performed to order the
identified item; and

in response to the single action being performed, sending to the
server system a request to order the identified item along with the
client identifier, the client identifier identifying account information
previously supplied by a user of the client system wherein the user
does not need to log in to the server system when ordering the item;
and

when account information is to be changed,

coordinating the log in of the user to the server system;

receiving updated account information; and

sending the updated account information to the server system
whereby the user does not need to log in to the server system when
ordering the item, but needs to log in to the server system when
changing previously supplied account information.

126. A method in a client system for ordering items, the method
comprising:

receiving from a server system a client identifier of the client system;
persistently storing the client identifier at the client system; and
for each of a plurality of items

displaying information identifying the item and displaying an
indication of a single action that is to be performed to order the
identified item; and

in response to the single action being performed, sending to the
server system a request to order the identified item and the
client identifier,

the client identifier identifying account information of a user
wherein the server computer automatically combines orders into a
single order.

151. A client system for ordering an item, comprising:

a component that receives from a server system a client identifier of
the client system and that stores the client identifier persistently;

a component that orders an item by displaying information identifying the item along with an indication of a single action that is to be performed to order the identified item and by sending to the server system a request to order the identified item along with the client identifier, the client identifier identifying account information previously supplied by a user wherein the user does not need to log in to the server system when ordering the item;
and a component that updates account information by coordinating the log in of the user to the server system, receiving updated account information from the user, and sending the updated account information to the server system.

176. A method in a computer for ordering an item, the method comprising:
providing to a client system a client identifier for the client system, the client identifier being associated with account information of a user and for persistent storage at the client system;
when an item is to be ordered,
providing to the client system a display page identifying an item, the display page including an indication of a single action that is to be performed to order the identified item;
receiving from the client system an indication that the user performed the single action along with the client identifier; and
generating an order for the identified item using the account information associated with the received client identifier wherein the user does not need to log in to the computer system to order the item;
and when account information is to be changed,
coordinating the log in of the user to the computer system;
receiving from the client system updated account information; and
updating the account information associated with the client identifier of the logged in user based on the received updated account information.

The claims are rejected as follows:

- Claims 108-123, 126-137, 151-156, 159-163, and 176-183 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of Hartman (US Patent 5,960,411) in view of Hafner (US Patent 5,893,076).
- Claims 108-117, 151-156, and 176-183 are rejected under 35 U.S.C. §103(a) as being unpatentable over Joseph (US Patent 5,819,034) in view of Teper (US Patent 5,815,665) and further in view of Official Notice.
- Claims 118-123, 126-137, and 159-163 are rejected under 35 U.S.C. §103(a) as being unpatentable over Joseph in view of Teper in view of Official Notice and further in view of Hafner (US Patent 5,893,076).

We REVERSE and REMAND.²

The obviousness-type double patenting rejection.

A. Issue

The issue is whether the Examiner has established a prima facie case of obviousness-type double patenting of the claims over the claims of Hartman in view of Hafner.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The Examiner found

... The claims of Patent "411" teach placing single action orders over an electronic network and the other claimed features of the

² Our decision will make reference to Appellants' Appeal Brief ("Appeal Br.," filed Aug. 17, 2006), the Examiner's Answer ("Answer," mailed Oct. 11, 2006), and to the Reply Brief ("Reply Br.," filed Dec. 11, 2006).

instant application, but does not specifically mention that the orders are combined or that a log in is required before server level information can be changed by the customer.

Hafner teaches a method and system for consolidating orders from multiple orders (col 8, lines 1-28 and col 10, lines 20-30). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the claims of "441" the consolidation capability as taught by Hafner, because this would facilitate increased optimization by better controlling inventory and shipping costs. The combination of "441" and Hafner teaches consolidating orders, but does not specifically mention all the time intervals and availability items of the instant claims. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to place time intervals on processing time and combining deliveries/orders based on availability. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of "441"/Hefner [sic, Hafner] placing time intervals on processing time and combining deliveries/orders based on availability, because this would assure that the orders are processed in a timely manner and would also allow orders to be combined in a manner that is optimized.

Further, the combination of "441" and Hefner [sic, Hafner] does not teach a log in required to change account information of the user. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to have a remote storage site containing personal information authenticate users before information could be changed. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include the coordination by the server of changes to stored personal data, because authenticating the user would assure that only the user that provided the information could change it, therefore, creating more security of personal information and preventing others from stealing or manipulating the otherwise secure data.

Answer 4-5.

2. Claims 1-26 of Hartman read as follows:
 1. A method of placing an order for an item comprising:

under control of a client system,

displaying information identifying the item; and

in response to only a single action being performed, sending a request to order the item along with an identifier of a purchaser of the item to a server system;

under control of a single-action ordering component of the server system,

receiving the request;

retrieving additional information previously stored for the purchaser identified by the identifier in the received request; and

generating an order to purchase the requested item for the purchaser identified by the identifier in the received request using the retrieved additional information; and

fulfilling the generated order to complete purchase of the item

whereby the item is ordered without using a shopping cart ordering model.
 2. The method of claim 1 wherein the displaying of information includes displaying information indicating the single action.
 3. The method of claim 1 wherein the single action is clicking a button.
 4. The method of claim 1 wherein the single action is speaking of a sound.
 5. The method of claim 1 wherein a user of the client system does not

need to explicitly identify themselves when placing an order.

6. A client system for ordering an item comprising:
an identifier that identifies a customer;
a display component for displaying information identifying the item;

a single-action ordering component that in response to performance of only a single action, sends a request to a server system to order the identified item, the request including the identifier so that the server system can locate additional information needed to complete the order and so that the server system can fulfill the generated order to complete purchase of the item; and

a shopping cart ordering component that in response to performance of an add-to-shopping-cart action, sends a request to the server system to add the item to a shopping cart.

7. The client system of claim 6 wherein the display component is a browser.

8. The client system of claim 6 wherein the predefined action is the clicking of a mouse button.

9. A server system for generating an order comprising:

a shopping cart ordering component; and

a single-action ordering component including:
a data storage medium storing information for a plurality of users;

a receiving component for receiving requests to order an item, a request including an indication of one of the plurality of users, the request being sent in response to only a single action being performed; and

an order placement component that retrieves from the data storage medium information for the indicated user and that uses the retrieved information to place an order for the indicated user for the item; and

an order fulfillment component that completes a purchase of the item in accordance with the order placed by the single-action ordering component.

10. The server system of claim 9 wherein the request is sent by a client system in response to a single action being performed.

11. A method for ordering an item using a client system, the method comprising:

displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item; and

in response to only the indicated single action being performed, sending to a server system a request to order the identified item

whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item.

12. The method of claim 11 wherein the server system uses an identifier sent along with the request to identify additional information needed to generate an order for the item.

13. The method of claim 12 wherein the identifier identifies the client system and the server system provides the identifier to the client system.

14. The method of claim 11 wherein the client system and server system communicate via the Internet.

15. The method of claim 11 wherein the displaying includes displaying an HTML document provided by the server system.

16. The method of claim 11 including sending from the server system to the client system a confirmation that the order was generated.
 17. The method of claim 11 wherein the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information.
 18. The method of claim 11 wherein the single action is a sound generated by a user.
 19. The method of claim 11 wherein the single action is selection using a television remote control.
 20. The method of claim 11 wherein the single action is depressing of a key on a key pad.
 21. The method of claim 11 wherein the single action is selecting using a pointing device.
 22. The method of claim 11 wherein the single action is selection of a displayed indication.
 23. The method of claim 11 wherein the displaying includes displaying partial information supplied by the server system as to the identity of a user of the client system.
 24. The method of claim 11 wherein the displaying includes displaying partial shipping information supplied by the server system.
 25. The method of claim 11 wherein the displaying includes displaying partial payment information supplied by the server system.
 26. The method of claim 11 wherein the displaying includes displaying a moniker identifying a shipping address for the customer.
3. The Examiner did not make a limitation-by-limitation comparison of a claim on appeal and a Hartman patent claim. Taking claim 108 on appeal as

representative of the claims being rejected, Hartman patent claim 13 appears to be the claim whose subject matter most closely matches the subject matter of claim 108 on appeal. The table below compares the two claims, the shaded portions in the table representing the subject matter they have in common.

<p>108. A method in a client system for ordering an item, the method comprising:</p> <ul style="list-style-type: none">receiving from a server system a client identifier of the client system;persistently storing the client identifier at the client system;when an item is to be ordered,displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item; andin response to the single action being performed,sending to the server system a request to order the identified item along with the client identifier, the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log in to the server system when ordering the item; andwhen account information is to be changed,coordinating the log in of the user to the server system;receiving updated account information; and	<p>11. A method for ordering an item using a client system, the method comprising:</p> <ul style="list-style-type: none">displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item; andin response to only the indicated single action being performed,sending to a server system a request to order the identified item <p>whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item.</p> <p>12. The method of claim 11 wherein the server system uses an identifier sent along with the request to identify additional information needed to generate an order for the item.</p> <p>13. The method of claim 12 wherein the identifier identifies the client system and the server system</p>
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sending the updated account information to the server system whereby the user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information.	provides the identifier to the client system.
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4. Claim 108 on appeal differs from Hartman patent claim 13 in that it includes the following limitations:
- persistently storing the client identifier at the client system;
 - the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log in to the server system when ordering the item;
 - when account information is to be changed, coordinating the log in of the user to the server system; receiving updated account information; and sending the updated account information to the server system; and
 - whereby the user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information.
5. The Examiner did not address all the differences between claim 108 on appeal and Hartman claim 13.

C. Principles of Law

1. A one-way determination of obviousness is needed to resolve the issue of double patenting where the application at issue is the later filed application. See, e.g., *In re Berg*, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998).
2. “Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier

patent and the claim in the later patent and determines the differences.’ *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. *Id.* at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting.” *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 968, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001).

D. Analysis

The first step in the obviousness-type double patenting determination is to construe a claim on appeal and a Hartman patent claim and determine differences between them. The Examiner did not make a limitation-by-limitation comparison of a claim on appeal and a Hartman claim and therefore an analysis including a construction of a claim on appeal and a Hartman claim, with a determination of the differences between them, is absent from the record. FF 3. It was left to us to determine which earlier claim in the commonly owned Hartman patent the Examiner determined rendered a claim on appeal invalid for obviousness-type double patenting. Our review of the Hartman claims (FF 2) leads us to the conclusion that, given claim 108 on appeal as representative of the claims rejected, Hartman patent claim 13 is the earlier claim whose subject matter most closely matches the subject matter of claim 108 on appeal. We have also determined the differences in subject matter between the two (FF 4).

We now proceed to the second step in the obviousness-type double patenting determination.

It is readily apparent that the Examiner has not addressed numerous limitations in the claims on appeal (FF 1) and none of the limitations that we have determined appear in claim 108 but do not appear in Hartman claim 13. For example, claim 108 (as well as claims 151 and 176) provide that the user does not need to log in to the server system when ordering an item. The Examiner does not appear to have addressed this. Appellants made this point in the Appeal Brief (Appeal Br. 11-12).

We note that the Examiner applied Hafner as evidence to show that it was well known to consolidate multiple orders. FF 1. This would apply to, for example, claim 126. But the Examiner does not explain whether Hafner shows “automatically” consolidating multiple orders, as required by, for example, claim 26. The examiner does not address that aspect of the claimed consolidating of multiple orders. This was a point Appellants made in the Appeal Brief (Appeal Br. 13).

As a result, the Examiner was not in a position to adequately determine whether the differences in subject matter between a claim on appeal and a Hartman patent claim render the claims patentably indistinct.

The Examiner did not satisfy the second step of the test for determining obviousness-type double patenting. As a result, the Examiner failed to make out a prima facie case of obviousness-type double patenting of a claim on appeal over a Hartman patent claim and the rejection is reversed.

E. Conclusion of Law

The Examiner has not established a prima facie case of obviousness-type double patenting of the claims over the claims of Hartman in view of Hafner.

The obviousness rejections

The record is not now in a condition for a meaningful review of these rejections. Accordingly, we will not treat these rejections on the merits but instead remand the application to the Examiner so that the Examiner may address the issues we detail below.

REMAND

There are two issues the Examiner should address upon remand of the application.

Written Description

The first issue is whether the claims satisfy the written description requirement of 35 U.S.C. §112.

We note that claims 108, 151, and 176 provide that the user does *not need to log in* to the computer to order an item and that claim 126 provides that the server computer *automatically* combines orders into a single order.

Our review of the prosecution history reveals the following facts. The application on appeal (09/318,447, filed 5/25/99) was filed with 48 claims. On 8/27/99, an amendment was filed canceling claims 1-48 and adding claims 49-107. For the first time, two new limitations were claimed. Claim 63 called for “the provided web page includes a request for log on

information.” Claims 59, 89, 101 and others called for “consolidating multiple orders placed ... into a single order.” On 12/24/02, an amendment was filed canceling claims 49-107 and adding claims 108-183 – many of which are now under appeal, including claims 108, 151, and 176 which provide that the user does *not need to log in* to the computer to order an item and claim 126 which provides that the server computer *automatically* combines orders into a single order.

The original claims do not mention providing that the user does *not need to log in* to the computer to order an item or providing that the server computer *automatically* combines orders into a single order as now claimed in claims 108, 151, and 176, and 126, respectively.

Turning to the Specification, we find only the following relevant disclosure:

- “In response to this selection, the server system may require the purchaser to perform a “login” so that the identity of the purchaser can be verified before shipping information is viewed or modified.” P. 7:16-18.
- “The server system may require the purchases [sic] to “login” so that the identify [sic] of the purchaser can be verified before the single-action ordering is enabled.” P. 8:17-19.
- “those orders may be cost effectively combined into a single order for shipping.” P. 8:24-25.
- “are combined into a separate order.” P. 9:5.
- “single-action orders can be combined” P. 12:5.
- “those sibling orders into a single combined order” P. 13: 10-11.

- “The algorithm then combines all the filled sibling orders into a single combined order” P. 13:15-16.

Accordingly, the Specification does not disclose providing that the user does *not need to log in* to the computer to order an item or providing that the server computer *automatically* combines orders into a single order as now claimed in claims 108, 151, and 176, and 126, respectively.

Given that neither the original claims nor the Specification disclose providing that the user does *not need to log in* to the computer to order an item or providing that the server computer *automatically* combines orders into a single order as now claimed in claims 108, 151, and 176, and 126, respectively, a question of patentability of the claims on appeal under the written description requirement of 35 U.S.C. §112, first paragraph is raised. Accordingly, we remand the application to the Examiner to consider whether the Specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Appellants were in possession of the invention as it is claimed; i.e., providing that the user does *not need to log in* to the computer to order an item (claims 108, 151, and 176) and providing that the server computer *automatically* combines orders into a single order (claim 126). See *Vas- Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 111, 117 (Fed.Cir. 1991). If not, the Examiner should reject the claims on appeal under 35 U.S.C. 112, first paragraph on the ground that the Specification fails to provide written descriptive support for the later-claimed subject matter (i.e., a new matter rejection).

We recognize that the Specification need not describe the claimed subject matter in ipssis verbis. But it appears here that, though the claimed subject matter is not explicitly disclosed, it is nevertheless not described in

terms that would reasonably convey to those of ordinary skill that Appellants had possession of the claimed subject matter at the time the application was filed. We recognize that the Specification discloses, for instance, that “[t]he server system *may require* the purchases [sic] to “login” so that the identify [sic] of the purchaser can be verified before the single-action ordering is enabled” (Specification, p. 8:17-19, emphasis added). But the Examiner should keep in mind that “[a] description which renders obvious the invention for which an earlier filing date is sought is not sufficient. ... It is not sufficient for purposes of the written description requirement of Section 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.” *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Obviousness

The second issue is the level of skill in the art at the time the application was filed.

In resolving the question of obviousness of the claimed subject matter over the prior art, the Examiner did not address the *Graham* factual inquiry into the level of skill in the art. During ex parte prosecution, this is not normally an issue that requires much attention since “the absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’” *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001). But in this case the Examiner reached conclusions of obviousness that necessitate factual findings relative the level

of skill in the art and, relatedly, what one of ordinary skill in the art would have known at the time the application was filed.

With respect to the rejection of claims 108-117, 151-156, and 176-183 under 35 U.S.C. §103(a) over Joseph, Teper, and Official Notice, the Examiner properly determined the scope and content of the prior art and the differences between the claimed subject matter and the prior art. Answer 5-10. However, the logic underpinning the apparent reasoning for combining the teachings of the references to reach the claimed invention depends on additional factual findings as to the level of skill in the art at the time the application was filed which are not now on the record. For example, the Examiner stated

... [t]he examiner takes Official Notice that it would have been obvious to a person having ordinary skill in the art to include in Joseph/Teper ... the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log into the server system when ordering the item (Per discussion above the combination of Joseph/Teper teach appending a stored identifier to gain access to personal information to automatically access stored account information thus eliminating the need to input the authorization each time the server is accessed)

Answer 6. In other words, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art to provide that the user does *not need to log in* to the computer to order an item. Here Joseph, the primary reference, concerns buying programs using interactive television where no logging in is required to purchase a program. The secondary reference, Teper, shows an online brokerage service with user authentication. There appears to be no dispute about this. In Appellants' words:

Joseph discloses storing information about the viewer (e.g., name, address, method of payment, and credit card number) in the

permanent memory of the client computer. The viewer can change or update this information with the TV remote control. As such, the viewer in Joseph's system does not log in to a server system to change account information because the account information is stored at the client computer. In fact, *Joseph does not mention logging in to the server computer, the client computer, or any other computer.* By contrast, *Teper's system requires the user to log in before the user can purchase an item and before the user can change account information.* For example, when a user connects to a Service Provider site and attempts to purchase an item, the Service Provider site requires the user to manually enter their password before the purchase is completed. Moreover, when a user connects to the Online Brokering Service to change or review account information, the Online Brokering Service requires the user to log in. Therefore, Teper's system always requires the user to log in before purchasing an item and before changing account information, and Joseph does not mention logging in.

Appeal Br. 21-22. Emphasis added. Accordingly, there is no dispute that the prior art shows aspects of the invention claimed in claims 108, 151, and 176, “*whereby [a] user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information*”. The question is whether one of ordinary skill in the authentication art would look to Joseph to modify an online purchasing method where no login is required and thus arrive at the claimed invention. This question depends on knowing the level of skill in the art and the knowledge a person of ordinary skill in the art would have had as of at least 1999 (i.e., the filing date of the application on appeal) in access control mechanisms and as they relate to different levels of security. Without knowing the level of skill in the art and the knowledge a person of ordinary skill in the art would have had as of at least 1999, there is no assurance, as the Examiner has reasoned, “that it would have been

obvious to a person having ordinary skill in the art to include in Joseph/Teper ... the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log into the server system when ordering the item.”

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) *the level of skill in the art*. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Emphasis added. *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar

elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; *and the background knowledge possessed by a person having ordinary skill in the art*, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. Emphasis added.

To resolve the level of skill in this case, the Examiner should address the facts set forth in the recent decision in *Daiichi Sankyo Co., Ltd. v. Apotex, Inc.*, 2006-1564 (Fed. Cir., Sep. 12, 2007), pp. 3-4:.

“Factors that may be considered in determining level of ordinary skill in the art include: (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.3d 1376, 1381-82 (Fed. Cir. 1983)). These factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art.

In this way the record will include evidence of the level of skill in the art and, as a result, all the *Graham* factual inquiries will have been addressed and the burden of establishing a prima face case of obviousness satisfied.

Our remarks above with respect to the rejection of claims 108-117, 151-156, and 176-183 apply as well to the rejection of claims 118-123, 126-137, and 159-163 under 35 U.S.C. §103(a) over Joseph, Teper, Official Notice, and Hafner. Here, too, additional evidence of the level of skill in the art would result in all the *Graham* factual inquiries having been addressed and the burden of establishing a prima face case of obviousness satisfied.

DECISION

The decision of the Examiner rejecting claims 108-123, 126-137, 151-156, 159-163, and 176-183 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of Hartman in view of Hafner is reversed.

We remand the application to the Examiner for consideration of a rejection of the claims on appeal under the written description requirement of 35 U.S.C. § 112, first paragraph. We also remand the application to the Examiner to resolve the level of skill so that the Board may be in a better position to review the rejections of claims 108-117, 151-156, and 176-183 are rejected under 35 U.S.C. §103(a) over Joseph in view of Teper and further in view of Official Notice and claims 118-123, 126-137, and 159-163 under 35 U.S.C. §103(a) over Joseph in view of Teper in view of Official Notice and further in view of Hafner. At the present time we will not treat these rejection on the merits.

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This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REVERSED AND REMANDED

vsh

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